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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,950	08/29/2000	Mark T. Gross	5038-41	8973

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EXAMINER

FLYNN, KIMBERLY D

ART UNIT PAPER NUMBER

2153

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/650,950

**Applicant(s)**

GROSS, MARK T.

**Examiner**

Kimberly D Flynn

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) 8-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is in response to an Amendment and Remarks filed November 23, 2004. Claims 1-7 and 14-17 are pending. Claims 8-13 are withdrawn from consideration.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- In considering claim 1, the limitation “extracting the configuration instructions from the e-mail message without parsing”. The specification does not contain a written description of the manner or process of “extracting the configuration instructions from the e-mail message without parsing” in clear, concise, exact terms as to enable any person skilled in the art to carry out this function.

Specifically there is no description of how a mail client on the appliance receives the e-mail (claim 6); extracts the configuration instructions from the e-mail message without parsing and configures the appliance according to the instructions. The specification fails to set forth the best mode contemplated by

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the inventor of carrying out the aforementioned function; therefore the function is not enabled.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 1 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In considering claims 1 and 14, the limitation stating “extracting the configuration instructions from the e-mail message without parsing” is ambiguous. It is unclear as what is meant by without parsing. Parsing is defined as “separating data so that a program can act upon the information”. Specifically it is unclear as to how the configuration instructions can be acted on if not parsed from the e-mail message.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinleib (6,272,532).

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In considering claim 1, Feinleib discloses a method for configuring an appliance across a network, comprising:

receiving configuration instructions via an e-mail message including the instructions in command format received at the appliance (Feinleib col. 2, lines 50-59);

extracting the configuration instructions from the e-mail message at col. 2, lines 64-67 through col. 3, lines 1-2 and also col. 4, lines 4-7; and

configuring the appliance according to the configuration instructions (col. 4, lines 11-13).

While Feinleib discloses extracting instructions from the e-mail message, Feinleib does not explicitly disclose wherein the extraction is done without parsing. Nonetheless, receiving the configuration instructions in the electronic mail in command format and identify the instructions “without parsing” would have been an obvious variation. As stated in the Applicant’s specification page 4, lines 4-9, the parser as part of the appliance is an **optional** component wherein the e-mail might be parsed into commands prior to arriving at the appliance or that the e-mail may be sent where the commands could be extracted or identified with no parsing. Because the parsing is optional, it would have been obvious to person having ordinary skill in the art, to incorporate the parser as an optional feature and to only parse documents or e-mails when parsing is necessary in order to directly reduce unnecessary processing time. Therefore the claimed limitation is an obvious modification the system as disclosed by Feinleib.

In considering claim 2, Feinleib discloses a method wherein the e-mail is received at a mail server on the appliance (Feinleib col. 2, lines 59-64).

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In considering claim 3, Feinleib discloses a method wherein the mail server on the appliance communicates is one of the group comprised of: an IMAP server, and a SMTP server (Feinleib col. 2, lines 59-66).

In considering claim 4, Feinleib discloses a method wherein the method further comprises running a mail daemon from the appliance, wherein the daemon monitors electronic mail for the device (Feinleib col. 5, lines 28-36).

Although the system taught by Feinleib discloses substantial features of the claimed invention, it fails to disclose the appliance always connected to the network. Nonetheless, the continual, uninterrupted connection of an appliance to a network would have been an obvious modification to the appliance disclosed by Feinleib, as many commercial devices are required to always be connected to the network in order to provide some type of requested service for end customers/clients. It would have been obvious for a person having ordinary skills in the art to modify Feinleib by always having the appliance connected to the network in order to provide 24/7 operations of usage for the appliance.

In considering claim 5, Feinleib discloses a method wherein the method further comprises connecting the appliance to the network to receive the mail message (Feinleib col. 5, lines 28-36).

In considering claims 6, Feinleib discloses wherein the e-mail message is retrieved at a mail client on the appliance (col. 2, lines 60-65).

In considering claims 7, Feinleib discloses wherein the mail client on the appliance communicates with a mail server on the network (col. 2, lines 60-65).

In considering claim 14, Feinleib discloses an article comprising:

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a storage medium, the storage medium having stored thereon instructions, that, when executed by a computing device, result in:

reception of an electronic mail message by a network appliance (col. 2, lines 50-59);

configuration of the appliance in accordance with the instructions contained in the electronic mail (col. 4, lines 11-13); and

While Feinleib discloses extracting the configuration instructions from the e-mail message at col. 2, lines 64-67 through col. 3, lines 1-2 and also col. 4, lines 4-7, Feinleib does not explicitly disclose wherein the extraction is done without parsing. Nonetheless, receiving the configuration instructions in the electronic mail in command format and identify the instructions “without parsing” would have been an obvious variation. As stated in the Applicant’s specification page 4, lines 4-9, the parser as part of the appliance is an **optional** component wherein the e-mail might be parsed into commands prior to arriving at the appliance or that the e-mail may be sent where the commands could be extracted or identified with no parsing. Because the parsing is optional, it would have been obvious to person having ordinary skill in the art, to incorporate the parser as an optional feature and to only parse documents or e-mails when parsing is necessary in order to directly reduce unnecessary processing time. Therefore the claimed limitation is an obvious modification the system as disclosed by Feinleib.

In considering claim 15, Feinleib discloses an article wherein the computing device is the network appliance (col. 5, lines 28-36).

In considering claims 16 and 17, although Feinleib discloses substantial features of the claimed invention, it fails to disclose the network appliance being a remote camera

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or Internet radio player. Nonetheless, those two appliances are commonly used as network appliances for applications such as WebCam and Real Audio Player, and would have been obvious modifications to the network appliance disclosed by Feinleib. It would have been obvious for a person having ordinary skills in the art to modify Feinleib by using a remote camera or Internet radio player in order to utilize a multitude of multimedia services and applications.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-7 and 14-17 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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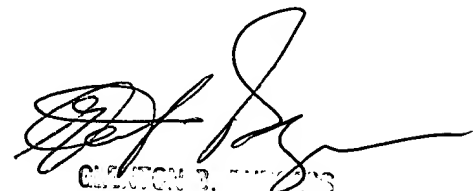
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D Flynn whose telephone number is 571-272-3954. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimberly D Flynn  
Examiner  
Art Unit 2153

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